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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/734,072	12/10/2003	Mark E. Tuttle	MI40-369	8908

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EXAMINER	
EVERHART, CARIDAD	

ART UNIT	PAPER NUMBER
2825	

DATE MAILED: 01/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/734,072	TUTTLE ET AL.	
	Examiner	Art Unit	
	Caridad M. Everhart	2825	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-53 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 19-53 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date 12-1-03,10-19-04.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Certificate of Corrections

A Certificate of Correction was issued July 16, 2002. The changes made by the certificate of correction have not been incorporated in the specification and claims as required. The applicant should include any changes that were made by the Certificate of Correction to the original patent grant in the reissue application without underlining or bracketing(MPEP 1411.01).

Certification Under 37CFR 3.73(b)

The 3.73(b) certification and the consent to reissue were both signed by Michael L. Lynch and are not acceptable because Michael Lynch has not established for the record that he is empowered to act on behalf of the assignee Micron Technologies, Inc.

Multiple Inventions

A restriction requirement was made in the original application dated 4/16/1999. The restriction required election between group I, claims 50-68, drawn to a semiconductor device and group II, claims 1-49, drawn to a process of making a semiconductor device. In the response to the restriction requirement filed 4-30-1999, applicant canceled claims 50-68, and elected the remaining claims. The reissue application adds new device/apparatus claims. The device/apparatus claims are drawn to a separate invention, .

Claims 20-38 and 44-53 are rejected under 35 USC 251 as attempting to correct an error not within the meaning of the reissue statute.

35 U.S.C. 251 particularly limits, through the "error" requirement, which types of errors are correctable by reissue. With respect to the correction of defects in claims, the patent must be "deemed wholly or partly inoperative or invalid...by reason of the patentee claiming more or less than he had a right to claim in the patent". No reissued claim can be obtained on subject matter which could not have been secured in the original patent. The issue is whether Applicant had a right to claim in the original patent what is now claimed in the reissue application. The Federal Circuit has adopted the previously established principle that applicants are "estopped from obtaining by reissue claims which, because of a requirement for restriction in which they had acquiesced, they could not claim in their patent." In re Watkinson, 900 F.2d 230,232, 14 USPQ2d 1407(Fed. Cir. 1990), quoting In re Orita, 550 F.2d 1277, 1280, 193 USPQ 145, 148 (CCPA 1977)(discussing In re Cornell, 150 F.2d 702,66 USPQ 320 (CCPA 1945) and In re Smyser, 135 F.2d 747, 57 USPQ 402 (CCPA 1943)). See also Weiler, 790 F.2d at 1582, 229 UKSPQ at 677.

Applicant acquiesced to a restriction requirement by deliberately canceling all of the claims not directed to a method of manufacturing a radio frequency device in response to the requirement for restriction(S.N. 08/847,123, Amendment filed 4-30-1999, page 1). Appellant's "right to claim" was thereby limited to the elected method of manufacturing a radio frequency device.

It appears that if claims 20-38 and 44-53 were presented during the prosecution of the '123 application, claims 20-38 and 44-53 would have been restricted out as being directed to a device/apparatus that would have been grouped with the non-elected invention(invention not belonging to elected group II). The main issue here is that the subject matter of claims 20-38 and 44-53 is independent and distinct from the subject matter of the elected and patented claims 1-18. Applicant would have had no right to examination and issuance of claims 20-38 and 44-53 in the original application after acquiescing to the restriction requirement.

Claims 1-18 of the patent are drawn to a method of making a radio frequency communication device, classified in class 438, subclass 19. Claim 20-38 and 44-53 of the reissue application are drawn to a radiofrequency device classified in class 343, subclass 872. The inventions are distinct, each from the other because the product as claimed can be made by another and materially different process(MPEP 806.05(f)). For example, rather than providing a recess within a substrate, a resin material could be provided around the circuit and the antenna on a substrate. Because these inventions are independent and distinct for the reasons given, these claims would have been withdrawn from condiseration as being directed to a non-elected invention if they had been presented in the '123 application.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 19 is rejected under 35 U.S.C. 102(b) as being anticipated by Inoue (US 4,960,983).

Inoue discloses a method of forming a device which includes the formation of a recess in a substrate(Fig. 6 shows a recess in the substrate body 52). The antenna portions 54a are shown in the recess. The antenna is a coil (col. 6, lines 13-26). An integrated circuit which includes a logic circuit is in the recess(col. 6, lines 13-26). It is connected(Fig. 6, element 54b) to the antenna(Fig. 6 and col. 6,lines 13-26). The antenna is seen to cross itself in that the windings cross each other as seen in Fig. 6, and as the antenna is coiled with a plurality of windings(col. 5, lines 27-40), and as shown in Fig. 6, dielectric is between the portions which cross each other, as 52 is dielectric material(col. 6, lines 16-19). Although Inoue discloses an induction coil, this is the same as an antenna.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 39-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marsh, et al. (US 5,566,441) in view of Leighton (6,514,367B1).

Marsh, et al disclose a method which includes the steps of forming a cavity in a plastic substrate(col. 1, lines 60-68); that the cavity slopes is seen in Fig. 19; an integrated circuit is provided in the cavity, which has radio frequency circuitry, as the circuit is a transponder(col. 1, lines 20-30 and col. 2,lines 14-15 which identifies the transponder as the circuit), which is known in the art to be a radio frequency circuit for transmitting a signal; the antenna is printed (col. 1,lines 27-29), and at least part in the cavity and part

on the upper part of the substrate(Fig. 19 and col. 5,lines 54-62); adhesive is used to adhere the antenna to the integrated circuit (col. 5,lines 30-35).

Marsh, et al does not teach the laminating a flexible plastic film step, although Marsh et al does disclose that the housing may have two components, between which the chip is located(col. 6,lines 20-25).

Leighton discloses a process for laminating an RFID card with a platic sheet and then printing ink on the card(col. 4, lines 59-62; col. 5, lines 39-43; col. 5, lines 45-52).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the process taught by Marsh, et al with the steps taught by Leighton in order to make the card taught by Marsh, et al easily identifiable and to provide a protective covering, and because Marsh et al contains the suggestion that the device may have an upper and a lower plastic portion in the lines cited above.

The prior art of record does not teach or suggest the limitations "the antenna is a loop antenna which crosses itself at a bypass" in combination with the other limitations of claim 1 and claim 11, nor "providing ...an entirety of an antenna within the recess...and a battery supported by the substrate" as recited in claim 2, nor "an antenna...a battery...wherein the antenna is provided within the recess and on a portion of the substrate outside of the recess" as recited in claim 3. Claim 6 recites a combination of these limitations. The prior art of record does not teach or suggest the limitations "pad printing a conductive material within the recess...placing a battery within the recess" as recited in claim 13. These limitations are also recited in claim 18.

on the upper part of the substrate(Fig. 19 and col. 5,lines 54-62); adhesive is used to adhere the antenna to the integrated circuit (col. 5,lines 30-35).

Marsh, et al does not teach the laminating a flexible plastic film step, although Marsh et al does disclose that the housing may have two components, between which the chip is located(col. 6,lines 20-25).

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Caridad M. Everhart whose telephone number is 571-272-1892. The examiner can normally be reached on Monday through Fridays 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew S. Smith can be reached on 571-272-1907. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

C. Everhart
12-12-2004